

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Mitchell D. Eggers

Confirmation No.: 9374

Patent No.: 7,584,240

Group Art Unit: 2442

Issue Date: September 1, 2009

Examiner: Robert B. Harrell

Appln. No.: 10/005,415

Filed: November 7, 2001

For: **AUTOMATED BIOLOGICAL SAMPLE ARCHIVE FOR STORAGE,
RETRIEVAL AND ANALYSIS OF LARGE NUMBERS OF SAMPLES**

Commissioner for Patents
Mail Stop Petitions
P.O. Box 1450
Alexandria, VA 22313-1450

**REQUEST FOR RECONSIDERATION OF
PATENT TERM ADJUSTMENT UNDER 37 C.F.R. §§1.704 & 1.705**

Applicants respectfully request reconsideration of the Patent Term Adjustment (PTA) determined for the captioned patent, which issued on September 1, 2009 as U.S. Patent No. 7,584,240. This request is timely filed within 2 months from the date of issue because November 1, 2009 was a Sunday, and this request is therefore, a timely response under 37 CFR §1.705(d).

The USPTO determined that the patent was entitled to 765 days of PTA. See attached USPTO PTA calculation. Applicants believe that this PTA determination was made in accordance with the USPTO's interpretation of the "Explanation of 37 CFR §1.703(f) and of the United States Patent and Trademark Office Interpretation of 35 U.S.C. §154(b)(2)(A)" published at 69 Fed. Reg. 34238 (June 21, 2004). Under that interpretation of the PTA statute, any USPTO delay under 35 U.S.C. §154(b)(1)(A) is deemed to overlap with any 3-year maximum pendency delay under 35 U.S.C. §154(b)(1)(B), and so as a practical effect, PTA may be awarded under 35 U.S.C. §154(b)(1)(A) or 35 U.S.C. §154(b)(1)(B), but never both.

On September 30, 2008, the United States District Court for the District of Columbia issued a decision holding that the USPTO's interpretation of the PTA statute was incorrect. See *Wyeth v. Dudas*, Civ. Action No. 07-1492 (JR) (Sep. 30, 2008). The court determined that the PTA statute should properly be interpreted so that "the only way that periods of time can overlap is if they occur on the same day." *Wyeth*, slip op. at 8. Thus, *Wyeth* holds that a USPTO delay under 35 U.S.C. §154(b)(1)(A) overlaps with a delay under 35 U.S.C. §154(b)(1)(B) only if the delays "occur on the same day." *Id.* Applicants are aware that this district court decision has been appealed to the U.S. Court of Appeals for the Federal Circuit (CAFC) (Fed. Cir. No. 2009-1120) but that no decision has yet been issued. Applicants, therefore, request that a decision on this request be held in abeyance until the CAFC decides this appeal, particularly because the oral argument for this appeal was heard on October 7, 2009.

Applicants have recalculated the PTA for the above-identified patent under the court's interpretation of the PTA statute in *Wyeth*, and have determined that the patent is entitled to 1435 days PTA, when taking into account the relevant delays under 37 CFR §§1.702(a) and (b), and under 37 CFR §§1.703(a) and (b). There was a 888 day delay by the USPTO under 35 U.S.C. §154(b)(1)(A) ("A Delay") and a 975 day delay by the USPTO under 35 U.S.C. §154(b)(1)(B) ("B Delay"), which should be added together totaling 1863 combined days minus any physically overlapping PTO delays (218 days) under 35 U.S.C. §154(b)(1)(A) and 35 U.S.C. §154(b)(1)(B) which equals 1645 days minus any Applicants' delay (210 days).

(a) Total of PTO delay under §154(b)(1)(A) & (B):	1863 days
(b) Total of overlapping PTO delay under §154(b)(1)(A) & (B):	218 days
(c) Total Applicant delay:	210 days
Final PTA Determination:	1435 days

Applicants therefore respectfully request that the patent be accorded 1435 days PTA or should this calculation be erroneous and Applicants would be entitled to additional PTA, it is kindly requested that the USPTO award a longer PTA if Applicants are so entitled under the *Wyeth* ruling.


The patent is subject to a terminal disclaimer.

Payment of the requisite fee is submitted herewith. However, because this PTA error is due to a Patent Office error in interpreting and applying the PTA statute, a refund of the fee is respectfully requested. The Commissioner is hereby authorized to charge any underpayment of fees associated with this communication, including any necessary fees for extensions of time, or credit any overpayment to Deposit Account No. 50-1283.

Respectfully submitted,
COOLEY GODWARD KRONISH LLP

Dated: November 2, 2009

By:


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10/005,415	AUTOMATED BIOLOGICAL SAMPLE ARCHIVE FOR STORAGE, RETRIEVAL AND ANALYSIS OF LARGE NUMBERS OF SAMPLES FOR REMOTE CLIENTS	11-02- 2009::15:48:43
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Patent Term Adjustments

Patent Term Adjustment (PTA) for Application Number: 10/005,415

Filing or 371(c) Date:	11-07-2001	USPTO Delay (PTO) Delay (days):	975
Issue Date of Patent:	09-01-2009	Three Years:	-
Pre-Issue Petitions (days):	+0	Applicant Delay (APPL) Delay (days):	210
Post-Issue Petitions (days):	+0	Total PTA (days):	765
USPTO Adjustment(days):	+0	Explanation Of Calculations	

Patent Term Adjustment History

Date	Contents Description	PTO(Days)	APPL(Days)
08-12-2009	PTA 36 Months	87	
09-01-2009	Patent Issue Date Used in PTA Calculation		
08-04-2009	Dispatch to FDC	⬆	
07-30-2009	Application Is Considered Ready for Issue	⬆	
07-31-2009	Mail Response to 312 Amendment (PTO-271)	⬆	
07-30-2009	Response to Amendment under Rule 312	⬆	
07-24-2009	Pubs Case Remand to TC	⬆	
06-09-2009	TC Return to Pubs	⬆	
06-08-2009	Amendment after Notice of Allowance (Rule 312)		54
06-08-2009	Issue Fee Payment Verified		2
06-09-2009	Mail Miscellaneous Communication to Applicant		⬆
06-08-2009	Issue Fee Payment Received		⬆
06-08-2009	Miscellaneous Communication to Applicant - No Action Count		⬆
04-23-2009	Pubs Case Remand to TC		⬆
03-06-2009	Mail Notice of Allowance		⬆
03-03-2009	Document Verification		
03-03-2009	Notice of Allowance Data Verification Completed		
02-23-2009	Paralegal TD Accepted		
01-22-2009	Date Forwarded to Examiner		
12-31-2008	Response after Non-Final Action		29
12-31-2008	Request for Extension of Time - Granted		⬆
06-04-2008	Electronic Information Disclosure Statement		⬆
12-05-2008	Mail Examiner Interview Summary (PTOL - 413)		⬆
11-25-2008	Examiner Interview Summary Record (PTOL - 413)		⬆
10-06-2008	Case Docketed to Examiner in GAU		⬆
09-02-2008	Mail Non-Final Rejection		⬆
08-30-2008	Non-Final Rejection		
06-04-2008	Information Disclosure Statement considered		
06-04-2008	Information Disclosure Statement considered		
06-03-2008	Electronic Information Disclosure Statement		

06-21-2008	Date Forwarded to Examiner	
06-21-2008	Date Forwarded to Examiner	
06-04-2008	Request for Continued Examination (RCE)	
06-21-2008	DISPOSAL FOR A RCE/CPA/129 (express abandonment if CPA)	
06-04-2008	Information Disclosure Statement (IDS) Filed	
06-04-2008	Information Disclosure Statement (IDS) Filed	
06-04-2008	Workflow - Request for RCE - Begin	
03-04-2008	Mail Final Rejection (PTOL - 326)	
03-01-2008	Final Rejection	
01-02-2008	Date Forwarded to Examiner	
12-12-2007	Response after Non-Final Action	
11-26-2007	Change in Power of Attorney (May Include Associate POA)	
11-19-2007	Correspondence Address Change	
09-12-2007	Mail Non-Final Rejection	
09-10-2007	Non-Final Rejection	
07-13-2007	Information Disclosure Statement considered	
07-24-2007	Correspondence Address Change	
07-13-2007	Information Disclosure Statement (IDS) Filed	3
07-13-2007	Information Disclosure Statement (IDS) Filed	⬆
07-13-2007	Date Forwarded to Examiner	⬆
07-13-2007	Date Forwarded to Examiner	⬆
07-10-2007	Request for Continued Examination (RCE)	⬆
07-13-2007	DISPOSAL FOR A RCE/CPA/129 (express abandonment if CPA)	
07-10-2007	Request for Extension of Time - Granted	
07-10-2007	Workflow - Request for RCE - Begin	
01-10-2007	Mail Appeals conf. Proceed to BPAI	
01-04-2007	Pre-Appeals Conference Decision - Proceed to BPAI	
11-28-2006	Request for Pre-Appeal Conference Filed	
11-28-2006	Notice of Appeal Filed	
08-28-2006	Mail Final Rejection (PTOL - 326)	
08-23-2006	Final Rejection	
06-27-2006	Date Forwarded to Examiner	
06-15-2006	Response after Non-Final Action	31
06-15-2006	Request for Extension of Time - Granted	⬆
02-15-2006	Mail Non-Final Rejection	⬆
02-14-2006	Non-Final Rejection	
12-27-2005	Date Forwarded to Examiner	
12-13-2005	Response after Non-Final Action	91
12-13-2005	Request for Extension of Time - Granted	⬆
04-05-2004	Reference capture on IDS	⬆

02-17-2004	Reference capture on IDS		⬆
06-13-2005	Mail Non-Final Rejection	888	
06-09-2005	Non-Final Rejection		⬆
12-14-2004	Case Docketed to Examiner in GAU		⬆
12-06-2004	Case Docketed to Examiner in GAU		⬆
11-17-2004	IFW TSS Processing by Tech Center Complete		⬆
04-05-2004	Information Disclosure Statement (IDS) Filed		⬆
04-05-2004	Information Disclosure Statement (IDS) Filed		⬆
02-17-2004	Information Disclosure Statement (IDS) Filed		⬆
02-17-2004	Information Disclosure Statement (IDS) Filed		⬆
11-12-2002	Case Docketed to Examiner in GAU		⬆
10-04-2002	Case Docketed to Examiner in GAU		⬆
04-09-2002	Case Docketed to Examiner in GAU		⬆
03-28-2002	Application Dispatched from OIPE		⬆
03-26-2002	Application Is Now Complete		⬆
03-08-2002	IFW Scan & PACR Auto Security Review		⬆
12-14-2001	IFW Scan & PACR Auto Security Review		⬆
11-07-2001	Initial Exam Team nn		⬆

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